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IN THE
Supreme Court of the United States

OCTOBER TERM 1944

No. 1251

THE WESTERN STATES MACHINE COMPANY

Petitioner,

v.

S. S. HEPWORTH COMPANY,

Respondent.

**PETITION FOR WRIT OF CERTIORARI AND
SUPPORTING BRIEF**

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DESIGNATIONS

The record consists of Volumes A, B, C, D and E.
Pages in the respective volumes are referred to as RA,
—, RB. —, etc.

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THE WESTERN STATES MACHINE COMPANY

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S. S. HEPWORTH COMPANY,

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**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT**

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATE
JUSTICES OF THE SUPREME COURT OF THE UNITED
STATES:

Your petitioner, The Western States Machine Company, respectfully prays that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit to review those portions of its judgment entered February 9, 1945 (RE. 203) as to which a petition for rehearing was denied (RE. 202) and by which claims of three United States patents were held either invalid or not infringed and a judgment enforcing the patents in the United States District Court for the Eastern District of New York (RA. 76-79) was thereupon reversed.

A certified transcript of the record including the proceedings in the Circuit Court of Appeals has been filed herein pursuant to Rule 38.

Jurisdiction

Jurisdiction is conferred by Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925, c.229 (U. S. Code, Title 28, Sec. 347).

Summary and Short Statement

The patents and claims in issue are:

- I. No. 1,758,901, filed Dec. 8, 1925, issued May 13, 1930, called the "Control" patent,—as to claims 1, 3, 4, 5, 9 and 10, held not infringed;
- II. No. 2,145,633, filed June 23, 1934, issued Jan. 31, 1939, called the "Separator" patent,—as to claims 10 and 12, held invalid; and
- III. No. 2,096,341, filed Nov. 30, 1934, issued Oct. 19, 1937, called the "Brake Cooling" patent,—as to claim 8, held invalid, and claim 9 held not infringed.

Each patent was granted for an invention of Eugene Roberts and is owned by petitioner (RA. 77).

The subject matter is sugar centrifugals. In making sugar, syrup is boiled until a hot, viscous mass of sugar crystals in molasses has formed. Heavy centrifugal machines, having perforated baskets to be whirled at high speeds, are used to separate the molasses and purify the crystals. Each centrifugal must be operated for many successive "cycles", treating a charge of 9 cubic feet or so in each cycle, to process an entire boiled mass. Then another mass is processed.

Eugene Roberts started working on such machines over 50 years ago, at age 15, as a mechanic in a beet sugar factory (RA. 181). He soon displayed inventive abilities and was granted patents, and he founded petitioner in 1918 to carry forward his work. Of the patents here involved the district court said:

"The plaintiff's patents were * * * successfully embodied in commercial structures which found a ready market from about 1926 until the filing of these suits. In other words, plaintiff's commercial success is not questioned. Commencing in 1936 the defendant inaugurated its own efforts to compete with the plaintiff * * *" (RA. 4).

1. The Control patent (Ex. 1, RB. 686, RA. 83) disclosed a sugar centrifugal controlled partly by hand and partly by automatic means, having a semi-automatic combination of driving, braking, spraying, timing and starting elements by which the centrifuging of any mass of crystals and syrup can be predetermined adjustably to suit the needs of the mass and then kept uniform for all of the many charges treated in the successive operating cycles required to process it all. Each mass differs from every other, and each mass is subject to changes of viscosity while awaiting treatment. Yet by the combinations of this patent each of the three phases of actual centrifugal treatment upon each charge can be adjusted and set to suit any quality of mass being processed; and the treatment so scheduled can be held the same for every charge in the successive cycles because the loading or starting and the discharging phases of the cycles are kept under normal manual control, to allow for the changes of quality and viscosity that occur, and when the sugar has been centrifuged in each cycle as scheduled the machine is quickly and automatically brought to a stop.

The Roberts invention dates from 1923 (RA. 71). It reduced waste, improved products, saved manpower and machines and made possible the scientific handling of

sugar refining work; and so it "proved to be an important contribution to the industry in which it was employed" (RA. 10).

The district court held that "the presumption of validity which has frequently been recognized as attaching to the grant of Letters Patent is well fortified as to these Roberts patents" (RA. 30), and patentable invention was found in that "a new and operable combination of several elements constituting together one machine is disclosed, which has been shown to perform an important, novel and useful function" (Finding 4a, RA. 71).

Respondent's machines (Ex's. 64-66, RB. 764-769, RA. 323, 325) were designed to use electrically and pneumatically motivated parts in place of mechanically and spring-motivated parts shown for corresponding service in the drawings of the Control patent. These were recognized as equivalents (RB. 739, RA. 207-208, 357, 400-401, 409-410) and were held to be so in the district court. The evidence was undisputed that the infringements charged use the features disclosed in the patent, to serve the same purpose and perform in the same way (RA. 402-410, 415-416, 417-418, 421, 492, 495), and they embody the claimed combinations completely, as to every element, operation and result. They are identical. This the district court meticulously explained (RA. 41-45), and the Circuit Court of Appeals conceded it as to the claims as they stand (RE. 169, 173).

In 1928, long after the Roberts invention, patent No. 1,669,927 was issued to *Carlson*, for an "Apparatus for Washing Sugar and the Like" (Ex. V, RB. 783, RA. 534). The patent was never used, and respondent's expert testified that it "does not identify a complete disclosure" (RA. 531). It proposed merely a combination of two incomplete timer elements arranged to operate a sprayer device and to be actuated by the drive connecting device of a centrifugal upon the start of basket rotation. The *Carl-*

son application, filed July 22, 1922, was pending in secrecy at the dates of the Roberts invention and application.

Respondent contended in the district court that its control mechanisms were more like *Carlson's* sprayer apparatus than like the control mechanism of Roberts, but the district court held otherwise:

"If only turning wash water on and off were involved in the Roberts patents, the contention would be formidable. Since that is not the Roberts invention, it seems that each control mechanism must be studied as a composite whole, and any useful comparison upon that basis points to their basic similarity in organization and performance" (Opinion R.A. 38).

The Circuit Court of Appeals, accepting the district court's statement of facts (RE. 168), called the Roberts invention one "to take the old centrifuges and make them automatic throughout" and said of *Carlson* that "the art had already made a centrifuge, automatic in all but the last phase: i.e. stopping the basket at the end of the drying period". It held that *Carlson* must be given effect as though published and known to skilled workers before Roberts' invention, when *Carlson* in fact was unknown; that since Roberts made his advance "only a year after *Carlson* filed his application, there would be no warrant for allowing it to be the basis of a patent"; that the claims might be circumscribed because of *Carlson* by reading in limitations from the specifications, if they were for a meritorious invention*; and that "whatever latitude remains to them, when so circumscribed, they will not cover the defendant's apparatus". In this way the judgment as to the Control patent was reversed, for non-infringement.

* The claims were granted after citation of *Carlson* (RE. 135), and they are clearly distinguished from *Carlson* as to the elements combined and the combinations, operations, and results as a whole.

11. The Separator patent (Ex. 4, RB. 693, RA. 83) disclosed the first successful apparatus for recovering separately the molasses and the purer wash syrup that result consecutively from purging and then washing the whirling charge treated in each cycle of sugar centrifugal operation. Roberts conceived it in 1933 (RA. 227-230). Of the prior art, the district court stated:

“* * * The evidence is undisputed that separation was required, and it was not accomplished successfully” (RA. 47).

The finding was of “patentable invention, which performed a useful and important function” (RA. 73), and infringement of claims 10 and 12 was found (RA. 74).

Respondent's main defense was that the claims were anticipated by a part of *Holland* patent No. 703,728, granted July 1, 1902 (Ex. TT, RB. 803). This was rejected in the district court, because of *Holland*'s lack of a corresponding teaching, the incompleteness and indefiniteness of his disclosure and its failure of use in more than 30 years of unfilled need that followed before Roberts' success (RA. 50-51). Yet the Circuit Court of Appeals gave to an unpatented part of *Holland*'s specifications (the description related to Fig. 4) a presumption both of operability and of sufficiency to advise the art of what Roberts claimed, saying that “the examiner passed the disclosure”, and it held thereupon that the claims were anticipated and that it was immaterial whether the prior patent were “as little a contribution to the sum of knowledge as though it had never existed” (RE. 174-175).

Holland's disclosure is ambiguous and incomplete on its face. There was evidence that the part of it relied upon was both impractical to make and inoperative (RA. 673, 675), but there was no evidence of its operability or sufficiency. Respondent simply offered the patent and had an employee relate his interpretation of Fig. 4 (RC. 545-547)—

an unreliable interpretation (RA. 669-672). The matter patented to *Holland* (RB. 803, Ex. TT, p. 1, lines 14-21, and p. 2, claims 1 to 4) is inconsistent with the description relied upon and clearly unlike the Roberts invention.

The invention *Holland* claimed would have an annular plate guide syrup to either of two places by having its outer edge always in contact with the curb so that syrup would always flow over the plate and its inner edge, to one side of a partition in one plate position and over the top of the partition to its other side in the other plate position. Several essentials of Roberts are thus lacking: (1) The seat or ledge on the curb with respect to which the outer edge of a ring deflector is either sealed or spaced away in the respective ring positions, (2) the ring deflecting syrup only in one position—to an inner trough when seated, (3) the ring overlying the partition of the inner trough, (4) the ring inactive—not guiding syrup—in its unseated position, (5) the single circular line of separation resulting from the above, and (6) disclosure of a way to work the ring.

The description of *Holland's* Fig. 4 speaks of having a space between the curb and the outer edge of the plate in the raised position of the plate, but even the description does not contain any of essentials (1), (3), (5) and (6) aforementioned.

III. The Brake Cooling patent (Ex. 5, RB. 695, RA. 83) disclosed a water-cooled brake system for sugar centrifugals, invented in 1934. It also achieved commercial success (RA. 56), and was found to "contribute an important element to high speed of rotation of the centrifugals and thus to the enhanced possibility of their performance in a given unit of time" (RA. 74).

The system embodies a brake drum on a vertical centrifugal shaft, constructed as an open top annular trough to hold a body of water while either rotating or at rest;

together with an offtake (shown as a scoop pipe) to remove heated water during each running period of the machine as the water body exceeds a certain volume determined by the capacity of the drum and the setting of the offtake; and together with an intake having a control device for supplying cool water to the body within the drum simultaneously with the action of the offtake. The intake control is coordinated with the centrifugal operation so that cool water is supplied only during the running periods while the offtake functions, the supply being terminated whenever the machine is brought to rest.

In this way water is kept from overflowing the drum or accumulating in it in such excess as to splash around the machine during the next running period. But the outstanding function of the system was the new capacity it imparted to the brake (RA. 241, 475, 503-506), which it accomplished in a new way by the constant maintenance of a body of water in the brake drum and the gradual replacement of heated water in this body by cool water between the successive brake operations (RA. 457, 461-463). Without this system and its effective graduation of temperature changes brake drums had quickly cracked and broken under the intensive strains imposed by short cycle centrifugal operations, wherein the brake must absorb the full kinetic energy of the heavy whirling machine, as heat, every two to three minutes (RA. 235-237, 503-504).

The only old element of the Roberts brake cooling system was the scoop offtake, which had been used since before 1928 in the *Baltimore Use*. There the centrifugal brake drum had bottom outlets, to discharge its water into a catch pan fixed below while the machine was at rest, together with a continuous intake at a limited rate (RA 641-642). Not only splashing (RA. 663-664) but low cooling capacity (RA. 644, 679) and early abandonment of attempts to market it (RA. 297) characterized the *Baltimore* system.

Respondent's machinery embodied the Roberts system

completely. It differs from the illustrations of the patent only in the substitution of a different intake control device coordinated to function in the system in the same way as Roberts' control valve, as explained in the opinion of the district court (RA. 59-63).

The district court, finding two distinctive features of patentable invention in the Brake Cooling patent, held claim 9 valid and infringed (RA. 59, 63) but considered claim 8 broadly readable upon the *Baltimore Use*, hence invalid (RA. 58, 59).

The Circuit Court of Appeals, in contrast, found claim 8 not anticipated, but dismissed it nevertheless by saying:

"There could be no invention in such a change as that: * * * one cannot have a patent merely for 'plugging up a hole.' Claim eight was either a useless variant, or it presupposed the stoppage of the supply; since the stoppage cannot be inferred because it occurs in claims nine and ten, claim eight is invalid" (RE. 176).

Then the Circuit Court of Appeals dismissed claim 9 for non-infringement, saying:

"* * * the claim must be read generally to cover all means which cut off the water; and to generalize the claim so far, would leave nothing for invention but the bare conception of turning off the water when the rim stops. * * * Claim nine may still be valid; we do not say; but, if it is, it covers only means which stop the water supply by a measurably similar mechanical train as that shown in the specifications: the defendant's apparatuses do not infringe it" (RE. 177).

Thus, there were three patents, each granted for a practical advance of a traditional inventor which performed in a new way, accomplished important new results and achieved commercial success. The district court stated that "* * * the accomplishments fairly to be attributed to the plaintiff's patents have been in the public interest * * *" (RA. 5). The Circuit Court of Appeals, for one

reason or another, has denied enforcement to all three patents by so changing or invalidating their claims as to destroy their effects. Yet nothing that existed before was the same or capable of equivalent performance, while the defendant's structures are the same for they are substitutes which clearly embody the inventions patented, even though their differences from details illustrated in the patents may make them appear different to the unskilled. The trial court reached quite the opposite result upon its full consideration and understanding of the evidence and the applicable law.

Questions Presented

1. Where the claims of a patent distinguish improvements and combinations of great utility from the prior art, is it now permissible for a court to change them by circumscribing them to illustrative details of the specifications, so as to hold them not infringed by machinery embodying the same improvements and combinations without the illustrative details?

2. Does the law now sanction the avoidance of infringement of claims to mechanical combinations and attendant destruction of their value through the device of so embodying the claimed combinations that the forms or details of parts used differ from the forms or details of parts used correspondingly in the illustrations of the patent?

3. Was it proper for the Circuit Court of Appeals to measure the extent of "invention" attributable to the Control and Brake Cooling patents and to change their claims to ineffectiveness by making simple characterizations of the verbal distinctions in the claims over the prior art and asserting that such characterizations could not "be the basis of a patent" or "could be no invention", where the record shows indisputably that each patent disclosed

and by its claims distinguishes a new, beneficial and successful combination or device which was never known or taught in the prior art?

4. Is a copending patent application which was filed earlier than but published long after the invention and application dates of a patent in suit to be considered as having on its filing date the same effect as a printed publication known to workers in the art, and as the base from which to start measuring the patentee's ingenuity, or how easy his invention might have been to skilled workers, or how long a period was required to bring it about, where the copending application does not disclose the claimed invention and so does not negative its novelty or show prior invention of it by others under the rule of this court in *Alexander Milburn Co. v. Davis-Bourneville Co.*, 270 U. S. 290?

5. Is there a legal presumption that matter described in part of an expired patent, as relied upon for the defense of anticipation of a later successful invention, was operable or sufficient to teach the art how to accomplish the result sought, where the prior patent was not granted for that matter but covers something different and non-anticipatory in its general description and claims of invention?

6. May a particular part of the specifications of an expired patent be presumed operable and sufficient to anticipate a patent in suit, where there is no evidence affirming its operability or its sufficiency but there is evidence of its inoperativeness and insufficiency and the result sought was accomplished only by the invention of the patent in suit, more than 30 years after the prior patent?

7. Is it immaterial that a prior patent asserted as an anticipation of a later successful invention was as little a contribution to the sum of knowledge as though it had never existed?

8. May the disclosure of a prior patent be presumed operable and sufficient to advise the art, and thereupon be held an anticipation of claims to a later successful invention, where the disclosure on its face is ambiguous, indefinite and incomplete as to the matter in question and contributed nothing to the practical art?

9. Is claim 8 of the Brake Cooling patent invalid merely because the essential novelty it sets forth seemed simple to the Circuit Court of Appeals or useless except in connection with other novelty disclosed in the patent, where the matter claimed has been used successfully to accomplish new results in both the patentee's and the infringer's commercial structures, and it was neither known nor taught by the prior art?

Reasons for Allowance of the Writ

1. The decisions of the trial court and the Circuit Court of Appeals are in direct conflict as to the principles of law and conclusions applicable to the same facts, and there is no likelihood of an adjudication in another circuit leading to a decision by this court because:

(a) The judgment precludes a further suit on the same issues against the respondent or customers of the respondent in another circuit;

(b) The business affected is small, consisting mainly in the replacement of existing machinery in sugar factories and refineries (RA. 186), which are relatively few in number, by specialized machinery embodying the inventions in suit (RA. 272-273); and none of the other concerns dealing in sugar centrifugals (RA. 274) is known to have infringed;

(c) The Control patent—most basic of those in suit—expires within two years, so that a further expensive suit

to protect it against infringements of future occurrence would hardly be practical, should cause arise; and

(d) Petitioner is a very small company having limited resources (RA. 180) which have been severely burdened by respondent's activities since 1936 and by the expenses of this suit. Petitioner is unable reasonably to afford a further similar suit should cause arise in the near future, and unless this court allows the writ there will be no protection of valuable rights duly granted by the Patent Office and believed unjustly denied protection by the Circuit Court of Appeals.

Writs of certiorari have been allowed by this court in like cases upon conflict between the trial and the appellate courts of one circuit, in *Hildreth v. Mastoras*, 257 U. S. 27; *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537; *Minerals Separation v. Hyde*, 242 U. S. 261; *Exhibit Supply v. Ace Patents*, 315 U. S. 126; and *Sinclair & Carroll Co. v. Interchemical Corp.*, 89 L. ed. 236 (memo.).

H. In respect of the Control patent and the effect thereupon of Carlson's copending application the Circuit Court of Appeals has decided an important question of federal law which has not been but should be settled by this court. It is important to the public and to the proper administration of the patent laws that this court decide whether the rule of the *Milburn* case properly may be extended to permit the use made of *Carlson* in this case; especially since the decisions of other federal courts¹ and

¹ *In re Spencer*, 47 F. (2d) 806, 807 (C. C. P. A., 1931); *Baltimore Paper v. Oles Envelope*, 13 F. Supp. 951, 954 (D. Md. 1936), aff'd. 89 F. (2d) 279 (C. C. A. 4th); *Hazeltine v. Coc*, 87 F. (2d) 558 (Appeals D. C.) and *Dyer v. Coc*, 125 F. (2d) 192, 196 (Appeals D. C.); *Johns-Pratt v. E. H. Freeman*, 201 Fed. 356 (D. N. J.), aff'd. 204 Fed. 288 (C. C. A. 3rd, 1913); *Utah Radio v. Delco*, 24 F. Supp. 328 (W. D. N. Y., 1938).

prior decisions of the Circuit Court of Appeals for the Second Circuit² conflict with the decision in this case; and since the practice in the Patent Office does not conform with the necessities of such decision.

III. In refusing to enforce claims of the Control and the Brake Cooling patents by limiting them beyond any fair construction of their terms, the Circuit Court of Appeals has unduly extended a restrictive policy toward patents declared by it in *Picard v. United Aircraft Corp.*, 128 F. (2d) 632, 636, and has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this court's power of supervision.

IV. In holding claims of the Separator patent anticipated by an unpatented and incomplete part of the specifications of the *Holland* patent, which the court presumed operable and sufficient to anticipate notwithstanding that the only evidence on the subject was to the contrary and regardless of whether *Holland* made any contribution to the sum of knowledge, the Circuit Court of Appeals has decided a federal question which has not been but should be settled by this court, and in a way probably conflicting with applicable decisions of this court in *Whitely v. Strague*, 7 Wall. (74 U. S.) 685, 686, *Coffin v. Ogden*, 18 Wall. (85 U. S.) 120, 124, *O'Reilly v. Morse*, 15 How. (56 U. S.) 62, 110, *Seymour v. Osborne*, 11 Wall. (78 U. S.) 516, 552, and *DuBois v. Kirk*, 158 U. S. 58, 65, as considered with the applicable decision in *Sewall v. Jones*, 91 U. S. 171, 185, 186, and other cases.

V. In its holding on claim 8 of the Brake Cooling patent the Circuit Court of Appeals has decided a federal

² *Stelos v. Hosicry*, 72 F. (2d) 405, 406 (C. C. A. 2nd, 1934);
Comolite v. Davidovicz, 111 F. (2d) 121, 123 (C. C. A. 2nd, 1940).

question in a way probably in conflict with applicable decisions of this court in *Deering v. Winona Harvester Works*, 155 U. S. 286, 302; *Diamond Rubber v. Consolidated Tire*, 220 U. S. 428, 440, 441, *The Barbed Wire Patent*, 143 U. S. 275, 282, and other cases.

VI. The decision of the Circuit Court of Appeals gives dangerous and unjust sanction and encouragement to the colorable evasion of patent rights through the designing of structures to use claimed inventions with parts or elements differing in detail or form from the details or forms illustrated in the patent, and through the praising of unwanted and non-anticipatory prior art to courts while using the claimed inventions instead. Thereby the court has withheld the protection assured by law for the origination and development of meritorious improvements, contrary to public policy and applicable decisions of this court.

By changing rather than fairly construing the claims in suit, and otherwise in deciding the questions aforementioned and reversing the judgment of the district court, the Circuit Court of Appeals has decided federal questions in ways conflicting with applicable decisions of this court in *Smith v. Snow*, 294 U. S. 1, 11-14; *Winans v. Denmead*, 15 How. (56 U. S.) 330, 341; *White v. Dunbar*, 119 U. S. 47, 51; *Cimiotto v. Am. Fur*, 198 U. S. 399, 409; *Minerals Separation v. Butte*, 250 U. S. 336; *Diamond Rubber v. Consolidated Tire*, 220 U. S. 428, 434, 435, 441; *Seymour v. Osborne*, 11 Wall. (78 U. S.) 516, 548, 553; *Minerals Separation v. Hyde*, 242 U. S. 261, 270; *The Corn-Planter Patent*, 23 Wall. (90 U. S.) 181, 223; *The Barbed Wire Patent*, 143 U. S. 275, 282, 283; *Sanitary Refrigerator v. Winters*, 280 U. S. 30, 41, 42; *Hobbs v. Beach*, 180 U. S. 383, 401; *Cochrane v. Deener*, 94 U. S. 780, 787; *Mason v. Graham*, 23 Wall. (90 U. S.) 261, 274; *Hildreth v. Mastoras*, 257 U. S. 27; *Williams v. United Shoe Machinery*, 316 U. S. 364; and other cases.

WHEREFORE, your petitioner respectfully prays that the writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit, to the end that this cause be reviewed by this court; that the judgment of the Circuit Court of Appeals be reversed; and that petitioner have such other and further relief as may be proper.

THE WESTERN STATES MACHINE COMPANY,

By ALBERT C. JOHNSTON,

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